

Appl. No. 09/868,276
Amdt. dated December 18, 2003
Reply to Office Action of June 24, 2003

REMARKS/ARGUMENTS

Claims 1-16 are pending in the application with claims 4-8 being withdrawn by the Examiner as drawn to non-elected subject matter. Support for all additions are found in the specification. For example, the definitions for X, Y and Z are found at page 17, at lines 9-14, of the Specification. Certain other additions and deletions were made to correct misspellings or typographical errors, or provide explicit limitations from claims as previously presented.

Claim Objections

Claims 10 and 15 are objected to as being substantial duplicates of claim 9. Applicants respectfully disagree. While each of claims 9, 10 and 15 are pharmaceutical composition claims, the scope of compounds utilized in the claims are different. In their original forms claim 9 recited compositions comprising compounds of claim 1; claim 10 recited compositions comprising compounds of claim 2; and claim 15 recited compositions comprising compounds of claim 12. Nevertheless, in the interest of expediting prosecution, claim 10 has been canceled and claims 9 and 15 are now believed to recite compositions having a clearly different scope.

Rejection of Claims 1-3, 9, 11-14 and 16 Under 35 USC § 112, Second Paragraph

Claims 1-3, 9, 11-14 and 16 stand rejected under 35 USC § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention.

Turning first to points (A), (B) and (C) raised by the Examiner, the present amendment addresses each of the concerns raised by The Examiner by correcting an improper valency for the term "OPO₃C₁₋₄ alkyl," and by correcting language for the ring that is formed and by identifying positions occupied by various substituents.

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With reference to point (D), the Examiner states, "[i]n claim 1 when B = Aryl/Phenyl; R2, R3, R4 = H, the claim can not differentiate the structures when R5 = H (or OH or Halogen etc., and when R1 = Halogen (or H or OH or other groups)." Applicants are unclear on the nature of the Examiner's objection is in this instance, and respectfully request clarification.

With reference to points (E) and (F), Applicants have amended the claims to provide the clarification requested by the Examiner.

In point (G), the Examiner states that the provisos of claims 1 and 2 are not very clear. The provisos serve to limit one of R⁷ or R⁸ to a basic group. This was done not to avoid prior art, but rather to best define the invention. It is not contemplated that the compounds of the invention would include a basic group at both these positions.

In point (H), The Examiner objects to method claims 12 and 16 depending from a compound claim. While Applicants believe the claims are proper, the present amendment addresses this matter.

In view of the above, Applicants respectfully request that each basis for this rejection be withdrawn.

Rejection of Claims 1-3, 9, 12-14 and Claims 11 and 16 Under 35 USC § 102(b)

Claims 1-3, 9, 12-14 and claims 11 and 16 stand rejected under 35 USC § 102(b) as allegedly being anticipated by Iwanowicz, et al., *Bioorg. & Med. Chem. Letters* 6/12 1339-1344 (1996); Kanda, Nobuo et al., EP 273 418, also cited as Chem. Abstr. DN 110:85613; and McKinnon et al., *Canadian J. Chem.* 66/6: 1405-9 (1988), also cited as Chem. Abstr. DN 109:190304.

The Examiner states that the compounds on page 1340 and Table 1 of the Iwanowicz reference anticipate the subjected matter recited in Claims 1-3, 9, 11, 12-14 and 16. The compounds described in the Iwanowicz reference are 2-phenyl-5-amidino-1*H*-indoles

wherein the phenyl may be substituted with hydroxy and the indole with methyl at the 3-position. In contrast, the present claims provide that when the phenyl moiety contains an ortho hydroxy substitution and the 5-amidinoindole moiety is not further substituted, then the phenyl moiety must contain at least one additional substitution. The present claims further provide that when the phenyl moiety contains only an ortho hydroxy substitution, then the 5-amidinoindole moiety must contain at least one additional substitution. The present claims further provide that when the phenyl moiety contains only an ortho hydroxy substitution and the 5-amidinoindole moiety contains only a substitution at the 3-position, then the substitution at the 3-position may not be methyl. Accordingly, the compounds disclosed in the Iwanowicz reference are not encompassed by Claims 1-3, 9, 11, 12-14 and 16 and do not anticipate the claimed subject matter.

In view of the above, Applicants respectfully request that this rejection be withdrawn.

The Examiner alleges that certain compounds described in European Patent Application No. 273418 (Kanda, Nubuo et al.) anticipate Claims 1-3, 9, 12-14. The Kanda reference describes certain 2-(2-hydroxyphenyl)-1*H*-indoles as intermediates in a synthetic process, wherein the indole moiety may be substituted at the 4-, 5-, 6- or 7-positions by a halogen atom, C₁₋₄alkyl, C₁₋₄alkoxy or halogenated C₁₋₄alkyl. The present amendment addresses this matter by clarifying that one, but not both, of R⁷ and R⁸ represents a basic group.

In view of this distinction between the present invention and the intermediates described by Kanda, Nubuo, et al., Applicants respectfully request that this rejection be withdrawn.

Similarly, the Examiner alleges that certain 2-phenyl-1*H*-indoles described by McKinnon et al. anticipate the claimed invention. Applicants respectfully note that R⁷ was identified by the Examiner as representing -C(=NH)-NH₂, -CONH₂ or -C(=NH)-NHNH₂ yet none of the compounds in McKinnon et al. possess such a group at the equivalent R⁷ position. Nevertheless, in an effort to expedite prosecution, the present amendment addresses this matter by clarifying that one, but not both, of R⁷ and R⁸ represents a basic group.

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In view of this distinction between the present invention and the compounds described by McKinnon, et al., Applicants respectfully request that this rejection be withdrawn.

Rejection of Claims 11 and 16 Under 35 USC § 112, First Paragraph

Claims 11 and 16 stand rejected under 35 USC § 112, first paragraph as the Examiner believes the specification, while enabling for treating arterial thromboembolism, does not provide enablement for prevention of thromboembolic disorders, and prevention of cancer.

Applicants disagree with the position taken by the Examiner. However, in an effort to expedite prosecution, Applicants have amended the claims to replace cancer and thromboembolic disorders with arterial thromboembolism. This amendment is made without prejudice toward pursuing the excised subject matter in a later filed continuation application.

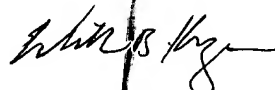
In view of the amendments to the claims, Applicants respectfully request that this rejection be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,



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